

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas L. CANTOR et al.

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES
FOR DETECTING PARATHYROID
HORMONE

Confirmation No. 4476

Examiner: C. Cheu

Group Art Unit: 1641

SUPPLEMENTAL INFORMATION DISCLOSURE
STATEMENT UNDER 37 C.F.R. § 1.97 & 1.98

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

Pursuant to 37 C.F.R. § 1.97 and § 1.98, Applicants submit for consideration in the above-identified application the document listed on the attached Form PTO/SB/08a/b. A copy of the document is also submitted herewith. The Examiner is requested to consider and make this document of record.

The document is a Second Amended Claim Construction Order from *Scantibodies Laboratory, Inc. v. Immunotopics, Inc.*, at the United States District Court for the Central District of California, Case No. CV 04-08871 MRP (MANx), now appealed as Case No. 2008-1522 at the United States Court of Appeals for the Federal Circuit. This litigation involves U.S. Patent No. 6,689,566. The present application is a Continuation-in-Part of U.S. Patent No. 6,743,590, which is a Continuation-in-Part of U.S. Patent No. 6,689,566. Scantibodies Laboratory, Inc. is the Patent Owner of U.S. Patent No. 6,689,566 and the assignee of the present application.

The Court vacated the previous claim construction order and reached the following construction of terms:

1. “Specific for” is defined as having a measurable affinity for and detectable binding to an epitope having at least four amino acids of the seven in SEQ ID NO: 3. In addition, the affinity is higher than the affinity for any other epitope of the whole PTH sequence.

2. “Specifically binds to whole parathyroid hormone” means having a measurable affinity for and detectable binding to whole parathyroid hormone.

3. “Does not specifically bind to an interfering non-(1-84) parathyroid hormone fragment” means having no measurable affinity for and no detectable binding to an interfering non-(1-84) parathyroid hormone fragment.

4. “Not detecting an interfering non-(1-84) parathyroid hormone fragment” is construed to mean having no detectable binding to an interfering non-(1-84) parathyroid hormone fragment.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☒ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
 - ☐ A fee is required. A check in the amount of __ is enclosed.
 - ☐ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly; no fee is believed to be due.

- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
- ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of __ is enclosed.
- ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing **532212000623**.

Dated: February 11, 2009

Respectfully submitted,

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